

Licensing INL Technology

License agreements between Battelle Energy Alliance (BEA), the Management and Operating Contractor at the Idaho National Laboratory (INL) and a business (or other entity) allow the business to reproduce, manufacture, sell, or use INL-developed or owned intellectual property. INL contractor-owned inventions are available for licensing for commercialization by U.S. and foreign companies and organizations. The INL licenses its intellectual property on much of the same terms as universities, other research organizations and industrial firms.

Grant of Rights

Various licensing terms may be negotiated, including both exclusive and non-exclusive license grants. Exclusive licenses may be in certain fields of use, geographic areas, or according to other terms. Co-exclusive and partially exclusive licenses, where exclusive rights to commercialize a technology may be shared by several organizations or restricted by area of use, territory or other terms, may also be granted. For example, one company may obtain exclusive rights to use and invention for applications in the energy industry while another exclusively licenses the same invention for applications in the food industry.

Royalties and Payments

INL licensing royalties comparable to those charged by universities, other research



Idaho National Laboratory has many technologies available for licensing to meet a variety of industry needs. INL's technology portfolios are organized by industrial area and are managed by Account Executives with experience in these industries.

organizations and the private sector. Licenses usually require an up-front, nonrefundable payment, royalty payments based on sales, and a minimum annual royalty. The fees will vary depending on the number of patents licensed, the demand for the technology, and the exclusivity of the license. Licensees obtaining foreign rights may be asked to pay the cost of preparing, filing, and prosecuting foreign patent applications, and the maintenance of all resulting foreign patents.

U.S. Government Retained License

As with all technology developed with federal funds, the U.S. Government retains a worldwide, non-exclusive, nontransferable, irrevocable, paid-up license to practice or have practiced any licensed intellectual property for or on behalf of the U.S. Government.

U.S. Preference

INL is required to preferentially license inventions to U.S.-based firms, particularly those that will develop and manufacture licensed products in the U.S. However, in appropriate circumstances, non-U.S. firms may receive licenses, including broad exclusive licenses, for the countries in which they operate or even receive exclusive worldwide licenses.

Technical Assistance

The Licensee is solely responsible for the commercialization of the licensed inventions. Under specific circumstances, INL may agree to provide technical assistance to the Licensee on a full cost recovery basis if the work is beneficial to the INL's mission objectives.

Continued next page



Continued from previous page

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Limited Warranty and Indemnification

Any license for INL technology will contain a disclaimer of warranties and require indemnification of BEA and the U.S. Government.

Non-Assignability

The license may extend to subsidiaries of the licensee or other parties, if provided for in the license, but will be non-assignable unless approved by the INL, except to the successor of that part of the licensee's business to which the invention pertains.

Sublicensing

An INL license may include the right to grant sublicenses under the license, subject to the approval of the INL. Each sublicense shall make reference to the license, including the rights retained by the Government, and a copy of such sublicense must be furnished to the INL.

DOE March-in Rights

The DOE has certain march-in rights to intellectual property developed with federal funding. Although rarely exercised, this right is in accordance with the Code of Federal Regulations.

Export Control

The license will contain a provision recognizing that the export of goods and/or technical data from the U.S. may require an export license from the U.S. Government. Failure to obtain an export license may result in criminal liability under U.S. law.

Licensing Activities During FY-2005

In 2005, twenty-four licenses were signed to industry partners ranging from national security to nuclear technologies.

A license was signed with proswat, Inc., a Boise, Idaho-based company, for the production and manufacturing of the Idaho Integrated Breaching Shotgun (IIBS). Designed and developed by engineers at INL the Breaching Shotgun is a combination of two firearms in one - a 12-gauge shotgun used to blast away door knobs or hinges, and a powerful rifle to deter and detain suspects.



In 2005, the Idaho Integrated Breaching Shotgun was licensed to proswat, Inc. for the production and manufacturing of the INL-developed technology.

The Breaching Shotgun was a collaborative project that involved several engineers and designers within the lab's National and Homeland Security Division. Designers spent more than a year developing the firearm into a functioning model that met all the requirements.

Paceco Corp., a California-based company who manufactures cranes for loading and unloading shipping and railroad containers, signed a license with INL to commercialize the Nuclear Materials Detection System. Paceco will combine its port operations and



Dr. James Jones developed the Nuclear Materials Detection System which has been licensed to Paceco Corp., a California-based company.

crane technology expertise with that of the nuclear material detection technology to support inspection system development and deployment at 300 of the nation's ports of entry.

In one 45-second pass over a 200 or 40-foot shipping container, port officials will be able to look directly through steel into the container, much the way an airport X-ray machine can look through luggage. If it can't see through something, it may indicate lead or other material being used to shield something that could include a nuclear active component (2005 *Idaho Business Review* article by Rick Carpenter).

Partnering with INL

The INL's goal is to find parties interested in commercializing lab-developed technologies. The INL invites interested parties to contact us regarding licensing opportunities.